TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1963

No. 109

WILBUR-ELLIS COMPANY, ET AL., PETITIONERS,

vs.

MAX K. KUTHER.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR CERTIORARI FILED APRIL 17, 1963
CERTIORARI GRANTED MAY 20, 1963

No. 17756

United States
Court of Appeals
For the Ninth Circuit

ALFRED LEUSCHNER, an Individual, Doing Business Under the Name and Style of Al's Machine Shop; and WILBUR-ELLIS COMPANY, a Corporation,

Appellants,

vs.

MAX K. KUTHER, an Individual,

Appellee.

Transcript of Record

Appeal from the United States District Court for the Northern District of California, Southern Division.

Phillips & Van Orden Co., 4th & Berry, S. F.—Rec. 3/28/62—Printed 4/23/62

INDEX

[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

	PAGE
Answer Cause No. 38418	7
Answer Cause No. 38859	13
Appearances	1
Certificate of Clerk	52
Complaint Cause No. 38418	3
Complaint Cause No. 38859	9
Exhibit, Defendant's:	
D—Affidavit of Alfred Leuschner	50
Exhibits, Plaintiff's:	
No. 1—Patent in Suit	39
10—Deposition of Alfred Leuschner	45
Findings of Fact and Conclusions of Law	26
Judgment	36
Memorandum of Opinion	15
Notice of Appeal	38
Statement of Points and Designation of Record, Appellants'	56

	Original	Print
Proceedings in the United States Court of Appeals for the Ninth Circuit	58	58
Minute entry of argument and submission	58	58
Minute entry of order directing filing of opinion and dissenting opinion and filing and recording of judgment	59	58
Opinion, Pence, J.	60	59
Dissenting opinion, Merrill, J.	64	64
Judgment	66	65
Clerk's certificate (omitted in printing)	67	65
Order allowing certiorari	68	66

APPEARANCES

NAYLOR & NEAL,
401 Russ Building,
San Francisco 4, Calif.,
Attorneys for the Appellants.

MELLIN, HANSCOM & HURSH,
391 Sutter Street,
San Francisco 8, Calif.,
Attorneys for the Appellees.

In the United States District Court, Northern District of California, Southern Division

Civil Action File No. 38418

MAX K. KUTHER, an Individual,

Plaintiff,

vs.

ALFRED LEUSCHNER, an Individual, Doing Business Under the Name and Style of Al's Machine Shop,

Defendant.

COMPLAINT FOR INFRINGEMENT OF UNITED STATES LETTERS PATENT No. 2,452,666

Comes Now Max K. Kuther, plaintiff above named, and for cause of action against the defendant above named, Alfred Lueschner, alleges:

I.

That plaintiff, Max K. Kuther, is a citizen and a resident of Monterey, County of Monterey, State of California, and has a place of business at Monterey, State of California.

II.

That defendant, Alfred Leuschner, is a citizen and resident of the State of California, and has a regular and established place of business at San

Jose, in the County of Santa Clara, State of California, within the jurisdiction of this Court, and is there doing business under the name and style of Al's Machine Shop.

III.

This Court has jurisdiction of this action because the same arises under the patent laws of the United States, being an action for infringement of Letters Patent of the United States.

IV.

That Letters Patent of the United States of America No. 2,452,666 were duly and regularly issued on November 2, 1948, all in accordance with law, and plaintiff, Max K. Kuther, is the owner of all of the entire right, title and interest in, to and under said Letters Patent No. 2,452,666, together with the sole and exclusive right to recover for infringement thereof since March 12, 1956.

V.

That defendant, Alfred Leuschner, has, within six years last past and prior to the filing of this complaint, and within the Northern District of California, Southern Division, infringed said Letters Patent No. 2,452,666, in that defendant, Alfred Leuschner, within six years prior to the filing of this action procured a number of machines from an unlicensed holder of such machines, which machines were manufactured in accordance with the

disclosure of said Letters Patent and within the scope of the claims thereof, and proceeded without license or authority to entirely rebuild said machines to adapt said machines to fill five-ounce cans, whereas said machines had been built to fill one-pound tall cans, that such rebuilding constitutes an act of infringement of the aforesaid Letters Patent.

VI.

That plaintiff, Max K. Kuther, is informed and believes and on information and belief alleges that defendant, Alfred Leuschner, has committed the aforesaid acts of infringement in knowing, wanton and deliberate disregard of the rights of plaintiff in the premises.

VII.

That plaintiff, Max K. Kuther, has been damaged by the infringing acts of defendant, Alfred Leuschner, in the amount of Eight Thousand Dollars ($8,000.00).

VIII.

That defendant, Alfred Leuschner, has had direct notice of said Letters Patent.

IX.

That plaintiff, Max K. Kuther, is informed and believes and on information and belief alleges that unless restrained by this Court, the defendant, Alfred Leuschner, will continue such infringing acts, all to the irreparable damage and injury of plaintiff.

Wherefore Plaintiff prays:

1. That an injunction, both pendente lite and permanent, issue out of and under the seal of this Court directed to the defendant, his attorneys, employees, and all those in privity with them, or any of them, enjoining them from in any manner committing any acts of infringement of Letters Patent No. 2,452,666.

2. That plaintiff have an accounting for his damages.

3. That the damages, when ascertained, be trebled in view of the wanton and deliberate character of the infringement.

4. That plaintiff have judgment against the defendant for reasonable attorneys' fees incurred by plaintiff in this action.

5. That plaintiff have judgment against the defendant for his costs and disbursements herein, and for such other and different relief as this Court may deem meet and proper in the premises.

MAX K. KUTHER,

By /s/ OSCAR A. MELLIN,
His Attorney.

[Endorsed]: Filed July 30, 1959.

[Title of District Court and Cause.]

No. 38418

ANSWER

Defendant answers the complaint herein as follows, the herein numbered paragraphs having reference to the correspondingly numbered paragraphs of said complaint:

1. Admitted.

2. Admitted.

3. Admitted.

4. Defendant admits that Letters Patent No. 2,452,666 were issued on November 2, 1948, and that the plaintiff is named as an inventor therein. For lack of information sufficient to form a belief defendant denies the balance of the allegations of paragraph IV.

5. Defendant admits that he has reconditioned four machines and has modified said machines to adapt them for filling five-ounce cans rather than one-pound tall cans, but denies the remaining allegations of paragraph V.

6. Denied.

7. Denied.

8. Admitted.

9. Denied.

Affirmative Defenses

10. Defendant alleges that Letters Patent No. 2,452,666 are invalid in that one or more of the conditions for patentability set forth in 35 U.S.C. 102, 103 has not or have not been complied with.

11. Defendant alleges that plaintiff has misused Letters Patent No. 2,452,666 in that he is attempting to expand whatever rights provided thereby to embrace machines which have long since passed out of whatever scope of monopoly afforded by said patent, and that plaintiff is therefore before this Court with unclean hands.

Wherefore Defendant Prays:

1. For a judgment of invalidity and/or non-infringement of Letters Patent No. 2,452,666.

2. For an award of attorney's fees.

3. For dismissal of the complaint.

NAYLOR & NEAL,
JAS. M. NAYLOR,
FRANK A. NEAL,

By /s/ FRANK A. NEAL,
Attorneys for Defendant.

[Endorsed]: Filed September 24, 1959.

In the United States District Court, Northern District of California, Southern Division

Civil Action File No. 38859

MAX K. KUTHER, an Individual,

Plaintiff,

vs.

WILBUR-ELLIS COMPANY, a Corporation,

Defendant.

COMPLAINT FOR INFRINGEMENT OF UNITED STATES LETTERS PATENT No. 2,452,666

Comes Now Max K. Kuther, plaintiff above named, and for cause of action against the defendant above named, Wilbur-Ellis Company, alleges:

I.

That plaintiff, Max K. Kuther, is a citizen and a resident of Monterey, County of Monterey, State of California, and has a place of business at Monterey, State of California.

II.

That defendant, Wilbur-Ellis Company, is a corporation of the State of California, and has a regular and established place of business in the City and County of San Francisco, State of California, within the jurisdiction of this Court.

III.

This Court has jurisdiction of this action because the same arises under the patent laws of the United States, being an action for infringement of Letters Patent of the United States.

IV.

That Letters Patent of the United States of America No. 2,452,666 were duly and regularly issued on November 2, 1948, all in accordance with law, and plaintiff, Max K. Kuther, is the owner of all of the entire right, title and interest in, to and under said Letters Patent No. 2,452,666, together with the sole and exclusive right to recover for infringement thereof since March 12, 1956.

V.

That defendant, Wilbur-Ellis Company, has, within six years last past and prior to the filing of this complaint, and within the Northern District of Calfornia, Southern Division, infringed said Letters Patent No. 2,452,666, in that defendant, Wilbur-Ellis Company, within six years prior to the filing of this action procured a number of machines from an unlicensed holder of such machines, which machines were manufactured in accordance with the disclosure of said Letters Patent and within the scope of the claims thereof, and proceeded without license or authority to cause said machines to be entirely rebuilt and to adapt said machines to fill five-ounce cans, whereas said machines had been

built to fill one-pound tall cans; that such rebuilding is of a nature that it constitutes an act of infringement of the aforesaid Letters Patent; and thereafter defendant sold said machines without license or leave of plaintiff.

VI.

That plaintiff, Max K. Kuther, is informed and believes and on information and belief alleges that defendant, Wilbur-Ellis Company, has committed the aforesaid acts of infringement in knowing, wanton and deliberate disregard of the rights of plaintiff in the premises.

VII.

That plaintiff, Max K. Kuther, has been damaged by the infringing acts of defendant, Wilbur-Ellis Company, in the amount of Eight Thousand Dollars ($8,000.00).

VIII.

That defendant, Wilbur-Ellis Company, has had direct notice of said Letters Patent.

IX.

That plaintiff, Max K. Kuther, is informed and believes and on information and belief alleges that unless restrained by this Court, the defendant, Wilbur-Ellis Company, will continue such infringing acts, all to the irreparable damage and injury of plaintiff.

Wherefore Plaintiff Prays:

1. That an injunction, both pendente lite and permanent, issue out of and under the seal of this Court directed to the defendant, his attorneys, employees, and all those in privity with them, or any of them, enjoining them from in any manner committing any acts of infringement of Letters Patent No. 2,452,666.

2. That plaintiff have an accounting for his damages.

3. That the damages, when ascertained, be trebled in view of the wanton and deliberate character of the infringement.

3. That the damages, when ascertained, be fendant for reasonable attorneys' fees incurred by plaintiff in this action.

5. That plaintiff have judgment against the defendant for his costs and disbursements herein, and for such other and different relief as this Court may deem meet and proper in the premises.

MAX K. KUTHER,

By /s/ OSCAR A. MELLIN,
His Attorney.

[Endorsed]: Filed January 27, 1960.

[Title of District Court and Cause.]

No. 38859

ANSWER

Defendant answers the complaint herein as follows, the herein numbered paragraphs having reference to the correspondingly numbered paragraphs of said complaint:

1. Admitted.

2. Admitted.

3. Admitted.

4. Defendant admits that Letters Patent No. 2,452,666 were issued on November 2, 1948, and that the Plaintiff is named as an inventor therein. For lack of information sufficient to form a belief Defendant denies the balance of the allegations of paragraph IV.

5. Defendant admits that it has caused the reconditioning of four machines and has caused the modification of said machines to adapt them for filling five-ounce cans rather than one-pound tall cans, but denies the remaining allegations of paragraph V.

6. Denied.

7. Denied.

8. Admitted.

9. Denied.

Affirmative Defenses

10. Defendant alleges that Letters Patent No. 2,452,666 are invalid in that one or more of the conditions for patentability set forth in 35 U.S.C. 102, 103 has not or have not been complied with.

11. Defendant alleges that Plaintiff has misused Letters Patent No. 2,452,666 in that he is attempting to expand whatever rights provided thereby to embrace machines which have long since passed out of whatever scope of monopoly afforded by said patent, and that Plaintiff is therefore before this Court with unclean hands.

Wherefore Defendant Prays:

1. For a judgment of invalidity and/or non-infringement of Letters Patent No. 2,452,666.

2. For an award of attorney's fees.

3. For dismissal of the complaint.

NAYLOR & NEAL,
JAS. M. NAYLOR,
FRANK A. NEAL,
By /s/ FRANK A. NEAL,
Attorneys for Defendant.

Certificate of service attached.

[Endorsed]: Filed February 17, 1960.

[Title of District Court and Cause.]

Nos. 38418 & 38859

MEMORANDUM OF OPINION

The above two cases, consolidated for the purpose of trial, involve similar subject matter and issues, namely, whether the defendants have infringed a valid patent of plaintiff in a fish canning machine. (Letters Patent, No. 2,452,666 issued November 2, 1948.)

It is alleged that the defendants procured a number of the patented machines from an unlicensed holder and proceeded without authority, to cause them to be entirely rebuilt and to adapt them to fill five-ounce cans, whereas they were built to fill one-pound cans only.

The defendants admit that they have caused the reconditioning of four of the machines to so adapt them but deny that they have in so doing infringed the patent.

The specific changes made by the defendants in converting the machines are admitted and enumerated in the deposition of defendant Leuschner who made the conversion for defendant Wilbur Ellis. Six essential parts of the patented combination were changed to accommodate the machines for the smaller size cans.

Conversion of the Machines

Thus, the question is presented whether it is infringement for the possessor of a patented combination, designed to pack one-pound cans only, to so change essential parts that the machine will pack five-ounce cans only.

In George Close v. Ideal Wrapping Machine Co., 29 F. 2d 533 (1st Cir. 1928), the Court, affirming the District Court, 23 F. 2d 848 (D. Mass. 1928), held that it was infringement for a defendant to convert patented caramel wrapping machines, designed to wrap caramels of a specific size, to wrap larger caramels, pointing out that such a reconstruction involving extensive change of essential parts, destroys the identity of the machine and results in a new, different machine, namely, a machine capable of wrapping an entirely different candy size.

In Miller Hatcheries, Inc., v. Buckeye Incubator Co., 41 F. 2d 619 (8th Cir. 1930), the Court held that it was infringement for a defendant to convert a patented egg incubator, designed to accommodate nine trays, to accommodate twelve trays, saying that such a reconstruction, involving extensive changes in essential parts, destroys the identity of the machine and results in a different machine of greatly increased capacity but embodying all the elements of the original patent.

In The Tabulating Machine Co. v. Durand, Sup. Ct. D. C. 1910; 156 Official Gazette, the Court held that

it was not infringement to change a patented automatic card sorting machine by one inch widening of the machine to enable it to handle larger cards, the Court saying that the change did not destroy the identity of the machine and that invention does not reside in the size of the machine alone but in its principle of novelty.

This Tabulating Machine case was noticed by the Court in the Ideal Wrapping Machine case (District Court decision, supra), but distinguished upon the ground that no showing had been made in the Tabulating case that the identity of the machine had been destroyed and, that the case was, therefore, one of repair and not of reconstruction.

Defendants in the pending cases concede that the Ideal Wrapping Machine and Miller Hatcheries cases, supra, favor plaintiffs' contention but contend that the recent case of Aro Manufacturing Co. v. Convertible Top Replacement Company, 365 U. S. 336, decided February 27, 1961, in effect overrules those cases by "delimiting impermissible reconstruction to those situations where there is a 'second creation' of the patented entity" and by holding that there can be no infringement where the replacement involves only some of the essential, but unpatented parts and, results in something less than a remaking of the patented entity.

In Aro, which involved the replacing of the worn out canvas top of a convertible automobile so that the patented combination of top and hardware was restored to its original condition, the Court held

that the replacement of the worn out essential part was permissible restoration of the article to the original use for which it was purchased. The Court did not say or hold that change of essential parts to give a different size or different use would be permissible reconstruction, nor was any such question presented.

Defendants argue, however, that if, as held in Aro, it is permissible to replace individually unpatented elements of an overall patented combination with identical elements, it should also be permissible to change the size, kind or location of the parts to vary the capacity or purpose.

Such reconstruction, defendants argue, pertains only to size and use and does not result in remaking of the patented entity.

W do not agree with this interpretation of the rule declared in Aro. When the change of essential parts is designed to change and in fact does change the capacity or effectiveness of the patented entity, the result is not only a new, but a different article, embodying the unique patented combination, but not made by the patentee to whom, alone, is reserved the right to make articles embodying the patented combination, in such amounts, in such sizes and for such purposes as he decides—or not to manufacture any articles at all, if he so chooses. (See: George Close v. Ideal, supra, at 537.)

When the patentee decides to manufacture and sell the patented combination so built as to handle

material of a given size, he impliedly chooses to refrain, as is his right, from manufacturing them to handle other sizes or for other purposes.

If the possessor is permitted, without liability for infringement, to so change essential unpatented parts of the combination as to enable it to handle material of different sizes, it follows that he could sell the article as changed and introduce into the public domain new, different machines, embodying the patented combination, despite the patentee's election not to build the combination for such sizes or purposes.

Such a reconstruction is clearly different from repair or replacement by the possessor of worn out parts to preserve the article in the condition in which it was manufactured and sold by the patentee.

In Leeds v. Catlin, 213 U. S. 325 (1908), a case noted approvingly in the Aro decision, Mr. Justice McKenna, speaking for the Court of the right to supply and use a phonograph record, part of a patented talking machine combination, pointed out that the intentional supplying of phonograph records, not to replace records deteriorated by use, or which had suffered breakage, constituted contributory infringement, insofar as the supplying of records indicated an intention merely to increase the repertory of tunes available to the purchaser of the patented combination.

There the Court concluded that the license granted to a purchaser of a patented combination does not extend beyond preserving its fitness for use "so far as it may be affected by wear or breakage." (at 336.)

Some opinions have gone further to indicate that a purchaser of a patented machine may go beyond repairs and improve the machine as he pleases. Chaffee vs. Boston Belting Co., 22 How. 217, 223 (1859); Aiken vs. Manchester Print Works, 1 Fed. Cas. No. 113 (C.C.N.H. 1865); Thompson-Houston Electric Co. vs. Kelsey Electric Ry., 75 F. 1005 (2d Cir. 1896).

Such references have not indicated, however, that by the term "improve" is meant a change to another purpose; rather a change merely to better perform the purpose originally intended by the patentee. Cf. Ideal Wrapping Machine Co., supra, 851. (District Court opinion.)

Indeed, the Court in Aiken, supra, Mr. Justice Clifford, stated: "The indubitable right of the defendants is to repair or improve the articles as long as they will last, but they cannot make new ones, nor can they in the exercise of their right to repair the old ones, infringe another man's patent." (at 247.)

Similarly, the Court in Thompson-Houston Electric Co., supra, modifying an order to allow a supplier of trolley stands to sell its products to electric railways for substitution of trolley stands (consid-

ered by the Court a non-vital element of a patented combination purchased from plaintiffs) to improve their stands through adaptation according to their needs, stated that its permission did not give defendant supplier authority to reconstruct or rebuild a combination which had been sold by the patentee.

Where Courts have gone further to allow a rebuilding of a machine under the notion that such change constituted a legitimate improvement, their error has been corrected upon appeal. See, National Cash Register Co. vs. Grobet (S.D.N.Y. 1906), reversed 153 F. 905 (2d Cir. 1907).

In this regard, we may also note that in the Miller Hatcheries case, supra, the Court said, at 621, that in addition to the right of repair, the purchaser of a patented device has the right, within certain limits, to change the device so as to make it adapted to his particular use, citing Thompson-Houston Electric Co., supra; Aiken, supra; and Wilson vs. Simpson, 9 How. 109, 125 (1850). The first two cases have already been discussed, and the last has no pertinence here.

We do not regard the reference in the Miller Hatcheries case to these cases as an expression of the view that the possessor of a patented combination may alter it to produce different results to his liking without being liable for infringement. Nor did the Court so regard these cases. As already noted, the Court held that the conversion of egg incubators so as to accommodate twelve trays instead of nine was an infringement.

Repair of the Machines

Although the issue is not tendered by the complaint, evidence was introduced without objection by defendant concerning, and both parties have argued, the further point that defendants infringed plaintiff's patent by reconstructing three machines, involving the patented entity, after the machines viewed as a whole, had become "spent" within the meaning of Aro.

The evidence on this issue is to the effect that these three machines had been owned by Hovden Food Products Corporation which shut down its Moss Landing plant in 1952. The machines were left in the plant building until 1958 when the plant, including the machines, was sold to a syndicate, lock, stock and barrel, without placing a price on the three machines which were apparently regarded as "junk." Defendant, Wilbur Ellis, subsequently purchased these three machines for $1250 each.

The machines had been unused, untended, exposed to rain and salt air, corroded and frozen solid to the extent that they were inoperable when acquired by Wilbur Ellis.

Wilbur Ellis arranged with defendant, Leuschner, to recondition the machines, and also to reconvert them for five ounce cans, at a cost of $1600 each, $1350 for the reconditioning and $250 for the structural conversion.

The reconditioning was accomplished by cleaning and sandblasting the corrosion to make the machine

operable. Certain can supports (27 on the drawings), although normally as long lived as the machines, had rusted away and were replaced. Certain plungers (28 on the drawings), originally designed of a diameter for one pound cans, were so corroded that they could be rendered operable only by grinding them down and thereby so reducing the diameter that the plungers would be no longer operable for one pound cans and would be operable at all only for smaller five ounce cans. Similarly, certain pockets (15 on the drawing) and compressors (19 on the drawing) could be salvaged only by inserts to change their original size.

In Aro, supra, the Court cited with approval, its previous decision in Wilson vs. Simpson, supra, to the effect that although there is no right to "rebuild" a patented combination, the entity exists notwithstanding the fact that destruction or impairment of one of its elements renders it inoperable; that, accordingly, replacement of that worn out essential part is permissible restoration of the machine to the original use for which it was bought; that such replacement of the worn out, damaged or destroyed part is but an exercise of the right "to give duration to that which he owns, or has a right to use as a whole." Ibid. The Court continued, that repair is not to be tested according to whether the replaced element is minor or major in relation to the whole, or according to its relative life span, or according to its essential relation to the whole; that a combination patent covers only the totality of the

elements in the claim and that no element, separately viewed, is within the grant; that maintenance of the "use of the whole" of the patented combination, through replacement of a spent, unpatented element does not constitute reconstruction; that reconstruction of a patented entity comprised of unpatented elements, is limited to such a true reconstruction of the entity as to in fact make a new article after the entity, viewed as a whole, has become spent—a second creation of the patented entity, as, for example, the discarded patented metal baling straps in Cotton Tie Co. vs. Simmons, 106 U. S. 89.

Applying these rules, the Court finds and concludes that the reconditioning of these three machines by cleaning, sandblasting and replacement, insofar as it restored them to their original condition after years of neglect and exposure did not result in the making of a new article or a second creation of the patented entity.

However, as previously noted, defendants did not rest satisfied with restoration of the machine to its original condition. They proceeded to change its elements, not to restore the original, but to build another machine designed to fill cans of a different size than the cans for which the original was manufactured and sold.

In so doing defendants, for the reasons already stated, infringed the rights reserved to plaintiff under the patent.

Defendants further claim that plaintiff's patents are invalid, because of prior art, as disclosed in Sanders, No. 1,935,997 (Ex. F), and Paynter, No. 218,813 (Ex. G), all patents for machines to pack salmon.

The evidence, however, shows that such machines would be useless for packing small fish, sardines, and that plaintiff's machines would be useless for large fish—salmon; that the machines are different in operation and purpose; that plaintiff's machines were extensively introduced into the sardine packing industry, and that they replaced hand packing with substantial economic savings; that defendant Wilbur-Ellis was, itself, a comparatively large buyer of the machines at prices of $8000-$10,000 each, prices which included profit to the patent licensees.

It is true that evidence of commercial success is not conclusive upon the issue of patentability, See Pointer vs. Six Wheel Corp., 177 F. 2d 153, 156 (9th Cir. 1949), but the evidence in the pending cases establishes that the differences between the subject matter of plaintiff's patent, on the one hand, and the prior art as disclosed in earlier patents, on the other, would be such as to render the plaintiff's patent valid.

For the reasons herein set forth, we are of the opinion that judgment should be entered in favor of the plaintiff and against the defendant in these actions. As prevailing party, plaintiff will prepare

findings of fact and conclusions of law in accordance with this memorandum opinion and in conformity with the Rules of this Court.

Dated: July 6, 1961.

/s/ W. T. SWEIGERT,
United States District Judge.

[Endorsed]: Filed July 6, 1961.

[Title of District Court and Cause.]

Nos. 38418 & 38859

FINDINGS OF FACT

1. Plaintiff, Max K. Kuther, is a citizen and resident of Monterey, County of Monterey, State of California.

2. Defendant, Alfred Leuschner, is a citizen and resident of the State of California and has a regular and established place of business at San Jose, County of Santa Clara, State of California, and is there doing business under the name and style of Al's Machine Shop.

3. Defendant, Wilbur-Ellis Company, is a corporation of the State of California, and has a regular and established place of business in the City and County of San Francisco, State of California.

4. Letters Patent of the United States No. 2,452,666 were duly and regularly issued on No-

vember 2, 1948, all in accordance with law, and plaintiff is, and has continuously been, the owner of all of the entire right, title and interest in, to and under said patent, together with the sole and exclusive right to recover for infringement thereof since March 12, 1956.

5. The patent in suit is directed to a combination of elements forming a machine for packing automatically small fish, such as sardines, into cans.

6. Machines manufactured in accordance with the disclosure of the patent were extensively introduced into the sardine packing industry and they replaced hand packing with substantial economic savings to the users of the machines.

7. Defendant, Wilbur-Ellis Company, was a comparatively large buyer of the above machines from the patent licensees at prices of Eight Thousand Dollars ($8,000.00) to Ten Thousand Dollars ($10,000.00) each, which prices included a profit to the patent licensees.

8. The prior art fish packing machines exemplified by the Sanders Patent No. 1,935,997 and Paynter Patent No. 2,189,831, were and are substantially different in construction, mode of operation and result from the machine disclosed by the patent in suit.

9. The prior art machines were designed to pack large fish, such as salmon, into cans and because of their construction and mode of operation, these

prior art machines would be useless and inoperative for canning whole small fish, such as sardines. In the prior art machines, the fish to be packed is dumped into a hopper, either in the form of cutting chunks of large fish or in random orientation if the fish are relatively small. The fish is then pushed from the hopper through a tunnel or conduit into a metering chamber. A knife severs the fish at the entry to the chamber to form a charge which is next compressed in the metering chamber and expelled into a can.

10. The machines of the patent in suit are designed to pack small fish, such as sardines, and because of their construction and mode of operation, these machines would be useless and inoperative for packing large fish, such as salmon. In the machines of the patent in suit whole small fish are delivered to open-top, U-shaped fish receivers in such orientation that the fish are headed half in one direction and half in the other direction so that the fish will be interlaced when packed in the can. A compressor member moves down into the U-shaped fish receiver and compresses the fish in the receiver so that all of the interlaced fish form a cylinder having a diameter slightly less than the can into which they are to be packed. Plungers then force the cylinder of fish from the receivers into the cans.

11. The above differences between the subject matter of the patent in suit and the prior art machines are substantial and are such that the subject

matter of the patent in suit would not have been obvious to a person having ordinary skill in the fish packing art at the time that the invention of the patent in suit was made.

12. The four machines involved in this suit were originally built with authority of the patentees and their licensees and were designed and operative to pack fish into one-pound size cans only.

13. Three of the four machines in suit had been owned by Hovden Food Products Corporation, which shut down its Moss Landing Plant in 1952. The machines were left in the plant building until 1958 when the plant was sold to a syndicate, lock, stock and barrel, without placing a value on the three machines which were apparently regarded as "junk." Defendant, Wilbur-Ellis Company, subsequently purchased these three machines in such condition. The machines had been unused, untended, exposed to rain and salt air, corroded and frozen solid to the extent that they were inoperable when acquired by Wilbur-Ellis Company.

14. Defendant, Alfred Leuschner, pursuant to the order of Wilbur-Ellis Company, cleaned and sandblasted the corrosion from the machines to make them operable. Certain can supports, although normally as long-lived as the machine, had rusted away and were replaced. Certain plungers, originally designed to a diameter for one-pound cans, were so corroded that they could be rendered operable only by grinding them down and thereby so re-

ducing the diameter that the plungers would no longer be operable for their original purpose, but would be useable for the smaller five-ounce size cans. Similarly, certain pockets and compressors could be salvaged only by inserts to change their original size.

15. Defendant, Wilbur-Ellis Company, bought the three machines for Twelve Hundred Fifty Dollars ($1,250.00) each and paid defendant, Alfred Leuschner, Sixteen Hundred Dollars ($1,600.00) for reconditioning and converting each machine, of which Thirteen Hundred Fifty Dollars ($1,350.00) was for reconditioning and Two Hundred Fifty Dollars ($250.00) was for converting each machine.

16. The mere reconditioning (not including the conversion to different can sizes) of these three machines by cleaning, sandblasting and replacement, insofar as it restored them to their original condition after years of neglect and exposure, did not result in the making of a new article or a second creation of the patented entity.

17. Defendant, Wilbur-Ellis Company, purchased the four machines in suit and authorized and directed defendant, Alfred Leuschner, to reconstruct and convert the four machines to pack fish in five-ounce size cans only, instead of one-pound size cans.

18. Defendant, Alfred Leuschner, redesigned and changed six essential parts of the patented ma-

chine in order to convert all four machines for filling the smaller size cans.

19. The conversion of the four machines changed the capacity and effectiveness of the machines by converting the machines to fill five-ounce size cans only, instead of one-pound size cans only.

20. The conversion of the machines resulted in the creation of not only new but different machines from those originally made by permission of the patentee, which new and different machines embody the novel combination claimed by the patent in suit.

21. The conversion of the four machines by defendants to fill different size cans is clearly different from the repair or replacement by the possessor of worn out parts to preserve the machines in the condition in which they were originally manufactured and sold by permission of the patentee.

22. The four accused machines are, in construction and mode of operation, substantially identical to the construction and mode of operation illustrated, described and claimed in the patent in suit No. 2,452,666, and in fact the drawings of the patent in suit were made from a machine which was the prototype of the accused machines.

23. There is no conflict in the evidence and defendants did not contest the fact that the four accused machines come squarely within the claims of the patent in suit, and indeed it is a fact that the

four machines as converted by defendants come squarely within the claims of the patent in suit.

24. Based on the evidence presented at the trial, a reasonable royalty for the use made of the invention by defendants is Fifteen Hundred Dollars ($1500.00) per machine. For the four machines involved in this suit such royalty is Six Thousand Dollars ($6,000.00).

Conclusions of Law

I.

This Court has jurisdiction of the subject and of the plaintiff and defendants.

II.

The plaintiff is and has continuously been the owner of all the right, title and interest in and to Letters Patent No. 2,452,666 in suit, including the right of action for past infringement thereof since March 12, 1956.

III.

Said patent is valid and has been infringed by defendants.

IV.

When the change of essential parts of a patented machine is designed to change and in fact does change the capacity or effectiveness of the patented machine such that the result is not only a new but different machine embodying the patented combination, rather than being merely permissible repair or replacement of worn parts, and when such

changes are made by other than the patentee without permission of the patentee, such acts constitute infringement of the patent on the patented machine.

V.

The decision and right to make a patented machine so as to handle material of a given size is the sole province of the patentee or his licensees, and when the patentee or his licensees decide to manufacture and sell a patented machine capable of handling only material of a given size, the patentee or his licensees impliedly have chosen to refrain, as is their right, from manufacturing machines for handling material of other sizes or for other purposes, and an unauthorized changing of a machine so built by the patentee or his licensees by a change of essential parts to convert such machine to handle material of a different size than the machine built by the patentee or his licensees is an act of infringement of the patent on such patented machines.

VI.

The acts of conversion or reconstruction of the machines in suit, which changed the essential parts in the patented machine so as to cause the changing of the capacity and effectiveness of the patented machine, is not at law the same as preserving the machine in the condition in which it was manufactured and sold by authority of the patentee. Instead, such acts created new and different machines embodying the patented invention, and such acts of conversion and reconstruction by defendants consti-

tuted an infringement of the patentee's rights under the patent in suit.

VII.

The acts of defendants in changing the elements of the patented machines in suit were not permissible restoration of the original machines, but were the unauthorized building of new machines of a different capacity and specific function than that for which the original machines had been manufactured and sold, and constitute infringement of the rights reserved to plaintiff, the patent owner under the patent in suit.

VIII.

Disregarding the changes in the machine to accommodate the packing of different size cans, the mere repair of the machines in suit so as to place the machines in operating condition was a permissible restoration of the patented combination.

IX.

The infringement of a patent entitles the injured party to general damages, measured ordinarily by the fair value of what was taken, i.e., the privilege of making, using or selling the patented article.

Faulkner vs. Gibbs,
199 F. 2d 635 (C.A.9, 1952);

Dowagiac Mfg. Co. vs. Minnesota Moline Plow Co., 235 U.S. 641, 648; 35 S.Ct. 221.

X.

Upon finding for the claimant, the Court shall award the claimant damages adequate to compen-

sate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the Court.

35 U.S.C. 284.

XI.

Plaintiff has been damaged in the amount of Six Thousand Dollars ($6,000.00).

XII.

Plaintiff is entitled to a judgment as against defendants, jointly and severally, adjudging said patent to be valid and infringed by defendants and awarding damages to the extent of Six Thousand Dollars ($6,000.00) to plaintiff.

XIII.

Said judgment shall also award taxable costs to plaintiff.

Dated: This 6th day of October, 1961.

/s/ W. T. SWEIGERT,
United States District Judge.

Approved as to form:

By /s/ FRANK A. NEAL,
One of the Attorneys
for the Defendants.

Date: October 5, 1961.

Receipt of copy acknowledged.

[Endorsed]: Filed October 6, 1961.

In the United States District Court, Northern District of California, Southern Division

Civil Actio[n] No. 38418

MAX K. KUTHER, an Individual,

Plaintiff,

vs.

ALFRED LEUSCHNER, an Individual, Doing Business Under the Name and Style of Al's Machine Shop,

Defendant.

Civil Action No. 38859

MAX K. KUTHER, an Individual,

Plaintiff,

vs.

WILBUR-ELLIS COMPANY, a Corporation,

Defendant.

JUDGMENT

This cause, having come on for trial before this Court, witnesses for both sides having been heard, documentary and physical exhibits having been received in evidence, briefs having been filed, and the Court having made its Findings of Fact and Conclusions of Law:

It Is Hereby Adjudged and Decreed as Follows:

I.

That this Court has jurisdiction of the subject matter and of the plaintiff, Max K. Kuther, and of the defendants, Alfred Leuschner and Wilbur-Ellis Company.

II.

That the plaintiff is the owner of all the right, title and interest in and to Letters Patent No. 2,452,666, together with the right of action for past infringement since March 12, 1956.

III.

That said Letters Patent is valid.

IV.

That said Letters Patent has been infringed by both defendants, Alfred Leuschner and Wilbur-Ellis Company.

V.

That damages in the amount of Six Thousand Dollars ($6,000.00) are awarded to plaintiff as against the defendants jointly and severally, and that plaintiff have execution therefor.

VI.

That plaintiff recover his taxable costs from the defendants, to be taxed by the Clerk in the amount of Two Hundred Fifty-Eight and 30/100 Dollars ($258.30), and that plaintiff have execution therefor.

Dated: This 6th day of October, 1961.

/s/ W. T. SWEIGERT,
United States District Judge.

Approved as to form:

NAYLOR & NEAL,
JAS. M. NAYLOR, ESQ.,
FRANK A. NEAL, ESQ.,

By /s/ FRANK A. NEAL,
Attorneys for Defendants.

Date: October 5, 1961.

Receipt of copy acknowledged.
[Endorsed]: Filed October 6, 1961.

[Title of District Court and Cause.]

Nos. 38418 & 38859

NOTICE OF APPEAL

Notice is hereby given that Wilbur-Ellis Company and Alfred Leuschner, defendants above named hereby appeal to the United States Court of Appeals for the Ninth Circuit from the final judgment entered in these actions on October 9, 1961.

Dated: November 7th, 1961.

Respectfully submitted,

NAYLOR & NEAL,
JAS. M. NAYLOR,
FRANK A. NEAL,

By /s/ FRANK A. NEAL,
Attorneys for Defendants-Appellants.

[Endorsed]: Filed November 7, 1961.

PLAINTIFF EXHIBIT NO. 1

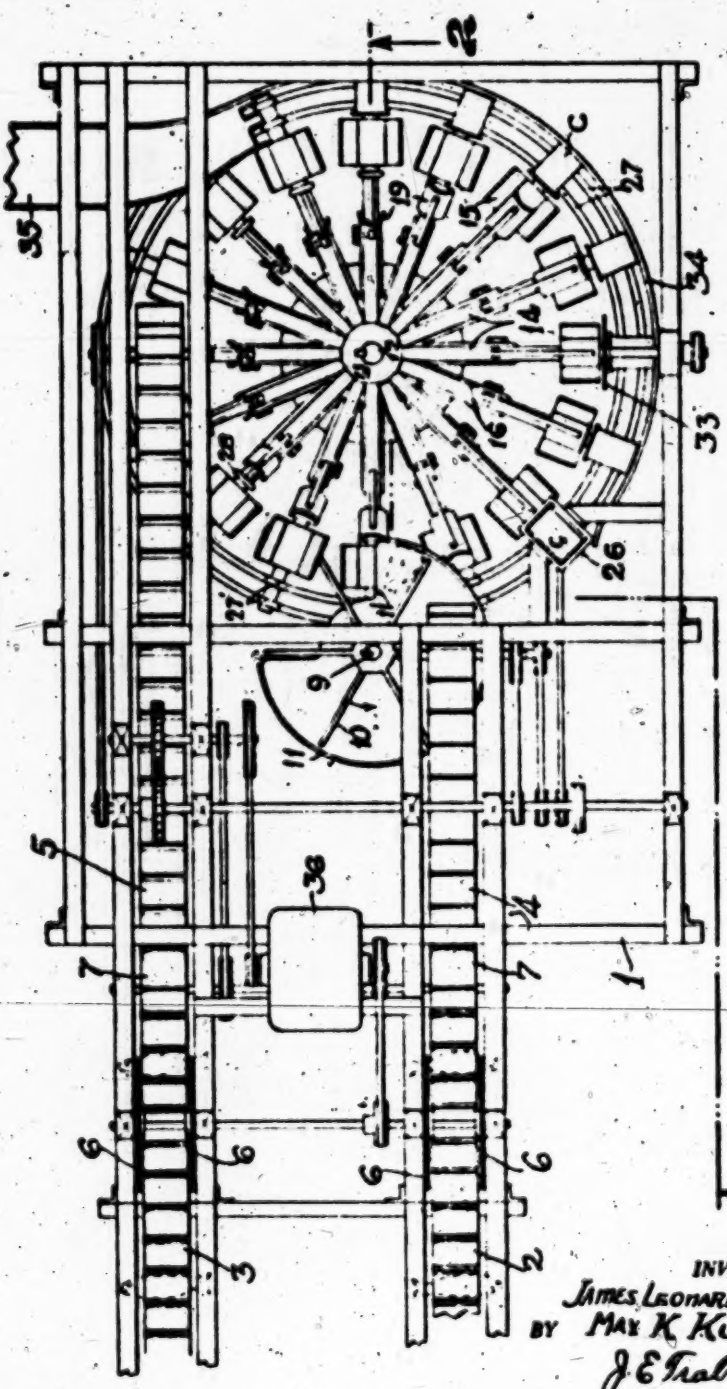
Filed April 4, 1958.

Nov. 2, 1948. M. K. KUTHER ET AL. 2,452,666

FISH CANNING MACHINE

Filed June 23, 1944 3 Sheets-Sheet 1

Fig. 1.



INVENTORS
James Leonard Smith &
BY Max K. Kuther
J. E. Trabucco
ATTORNEY.

and the discharge opening 11' of the receptacle 11. The movement of the conveyor 8 and the rotation of the table 13 are synchronized so that a predetermined number of fish are deposited into each fish receiver 15 as it passes under the discharge end of the supporting plate 8'. In the particular example herein illustrated, there are two fish deposited with their larger ends disposed outwardly into each fish receiver from the supporting plate 8'. When each fish receiver 15 having the two already deposited fish therein reaches the discharge opening 11' of the receptacle 11, there will be deposited therein from the said receptacle two additional fish, making in all four fish. The position of the fish discharged from the receptacle 11 into each receiver will be such that their larger or head ends are pointed inwardly in the opposite direction to the two fish previously entering the receiver from the plate 8'. The counter-clockwise movement of the wheel 10 is so timed with respect to the similar movement of the table 13 and the arms 14 that two fish from the receptacle 11 are discharged into each receiver 15 when it reaches a position directly below the point of discharge. The inclined side wings of each of the receivers 15 provide suitable means for directing the received fish into the central part of the receiver where they are subsequently compressed. Associated with each fish receiver 15 is means for compressing the fish into a compact package prior to their being transferred into a can. The various fish compressing means being the same, a description of one will suffice for all. Secured to and extending upwardly from the opposite side edges of each arm 14 are spaced supports 16. Secured to a pivotal shaft 17 mounted on the supports 16 is a gear 18 and a fish compressing member 19, the latter having a semicircular end part which is of substantially the same shape as the central part of each fish receiver 15. The fish compressing member 19 is adapted to move downwardly to a position where it engages with the fish receiver 15. When the receiver and the compressing member are in engaging positions, they form a cylindrical device, open at its ends, within which the four fish may be compressed prior to their being transferred into a can. (See Figs. 3 and 4.) The fish compressing member 19 is moved upwardly and downwardly with timed reciprocating motion by means of a lever 20 having a gear 21 at one end which is in mesh with the gear 18 secured to the shaft 17. The lever is pivotally secured as at 22 to one of the supports 16 and its opposite end is provided with a roller 23 which engages externally with a suitably shaped cam 24 supported beneath the table 13. This cam 24 is of general semicircular shape and through the lever 20, the gears 21, 18 and the shaft 17, it serves to move the fish compressing member 19 downwardly to a position whereby it engages with the upper surface of the fish then located in the receiver 15. Complementary to the cam 24 is another cam 25 of general semicircular shape which is engaged internally by the roller 23 of the lever 20 after the said roller disengages with the cam 24. This latter cam serves to raise the fish compressing member 19 upwardly preparatory to its succeeding compressing operation. The movement of the fish compressing members 19 is such that they are in raised positions above the fish receivers 15 when the fish are being deposited therein. The movement of each of the compressing members 19 in a

[illegible] this being [illegible] the receiver 15 passes the discharge opening 11' in the receptacle 11. It will be noted in Fig. 1 that the fish compressing members 19 assume different positions depending upon where they happen to be with respect to the points where the fish is admitted to the receivers 15 and where it is subsequently compressed preparatory to being transferred into a can.

Arranged in a predetermined position with respect to the discharge opening 11' of the receptacle 11 is a can delivery chute 26 which has its open discharge end positioned directly above a duplex ring-shaped track 27 secured to and carried circularly by the arms 14 (see Fig. 6). The track 27 has a plurality of uniformly spaced grooves 27' each of which is adapted to receive a can C dropping onto the track from the delivery chute 26. The lower end of the can delivery chute 26 has an opening 26' at one side which allows a can C then lodged in a groove 27' to be carried by the circularly moving track 27 past the said chute (see Fig. 6). Directly after the movement of a can C beyond the can delivery chute, the transfer of the compressed fish into the can is accomplished. Each arm is equipped with the same transfer means. Slidably mounted on each arm for outward and inward reciprocating motion through a fish receiver 15 is a pusher or plunger 28 which has a connecting rod portion extending through a supporting guide 29 on the arm. The pusher 28 is rigidly connected to a depending rod 30 extending through a slot in the arm and having a roller 31 at its lower end which engages exteriorly with a suitably shaped cam 32 supported beneath the table 13 in a position inwardly from the cam 24. A complementary cam 32' is engaged internally by the roller 31 to return the pusher to its normal position. The cam 32 is of general semicircular shape and through the roller 31 and the rod 30 it serves to move the pusher 28 outwardly against the fish then held in a compressed position inside the receiver 15. Through the cam 32 the outward movement of the pusher 28 is timed so that the compressed fish then clamped in the receiver 15 by the compressing member 19 will be pushed into the can C through the latter's inwardly disposed open end. The action of the pusher 28 in an outward direction and then inwardly is quite fast and such movement is so synchronized with respect to the compressing member 19 that the latter is in its extreme downward compressing position when the pusher is moved outwardly. Thus the compressed fish is automatically transferred into the can without loss of any substantial portion thereof. As the cans C with the fish therein are carried further in a counter-clockwise direction, they successively come to a circular rotating knife 33 which is so positioned as to cut off any excess fish which might be protruding from the open end of the can.

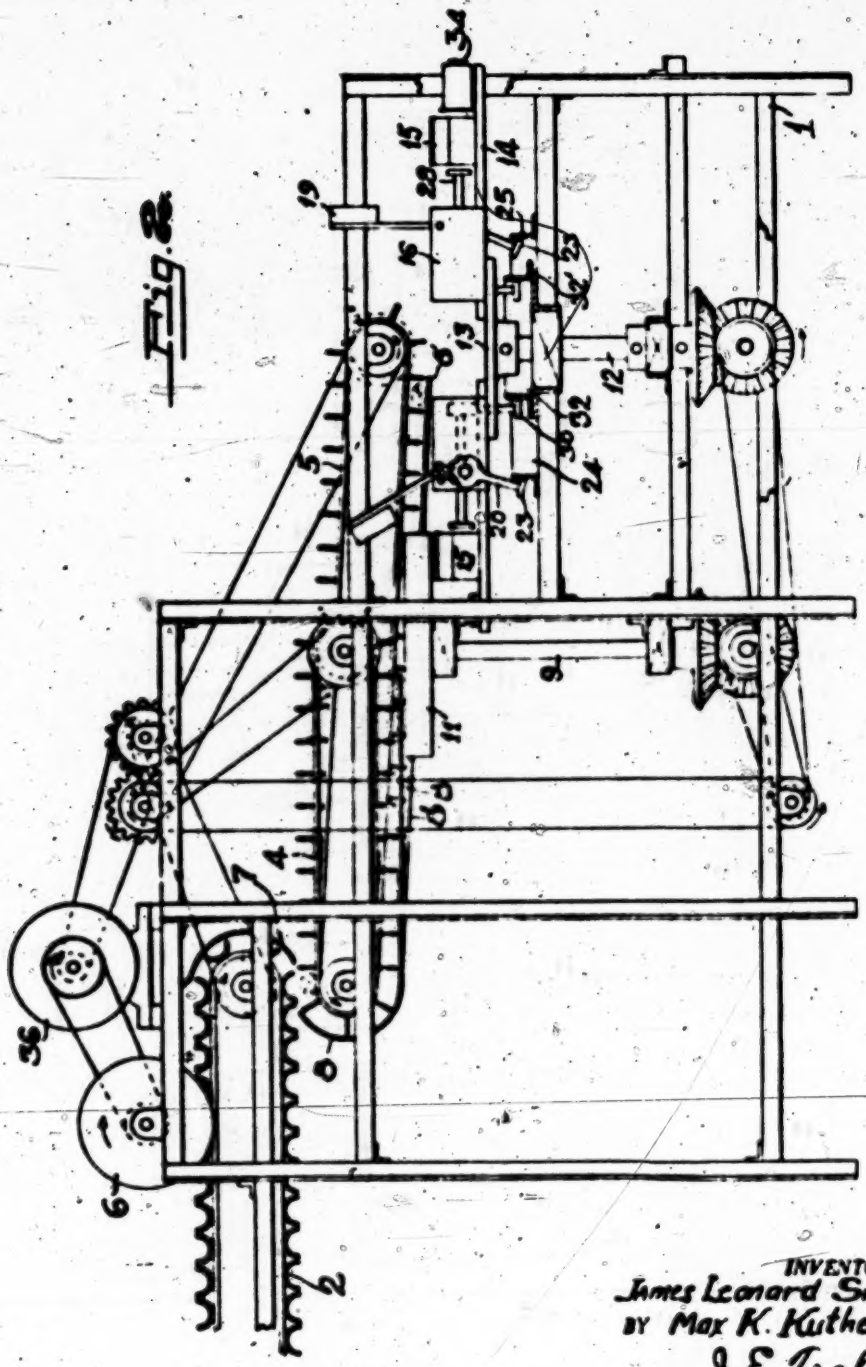
In order to brace the cans C and to maintain them against displacement when the pushers 28 are actuated to transfer the compressed fish thereto, a semicircular member 34 is arranged to engage with the closed ends of the cans at points where there will be an outward pressure from the pushers. The circular member 34 extends partially around the track 27 and merges into and provides one side of a can discharge chute 35. The continued circular movement of the filled cans C brings them to the discharge chute 35 into which they are suitably directed for transfer to a processing unit or cooker.

Nov. 2, 1948. M. K. KUTHER ET AL 2,452,666

FISH CANNING MACHINE

Filed June 23, 1944 3 Sheets-Sheet 2

Fig. 2.



INVENTORS
James Leonard Smith
BY Max K. Kuther
J. E. Trabucco
ATTORNEY.

Nov. 2, 1948. M. K. KUTHER ET AL 2,452,666

FISH CANNING MACHINE

Filed June 23, 1944 3 Sheets-Sheet 3

Fig. 3.

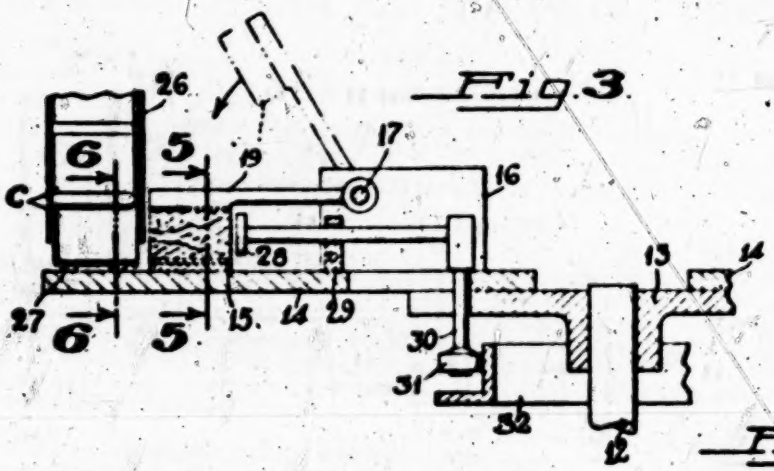


Fig. 4.

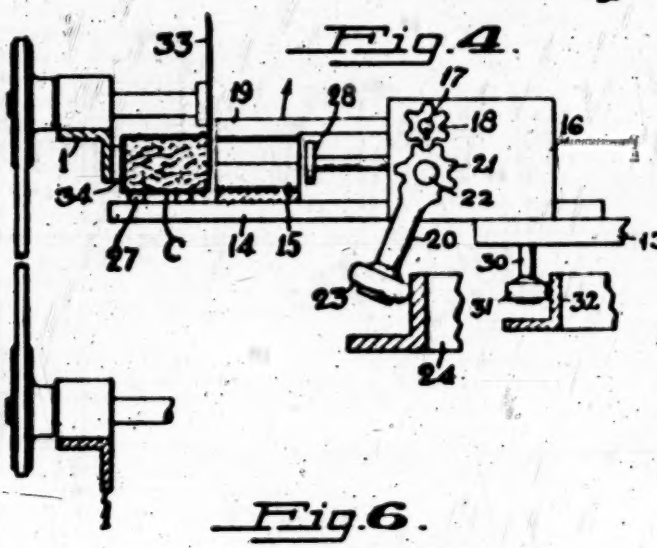


Fig. 5.

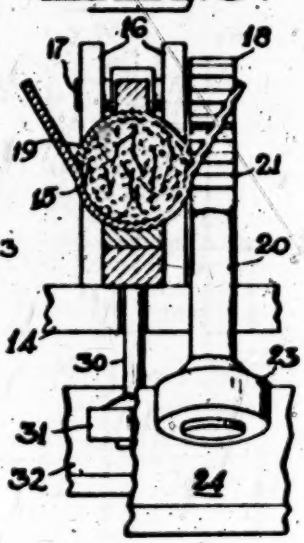
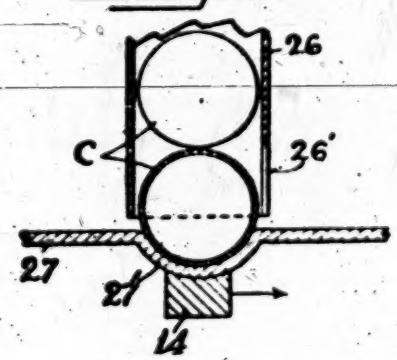


Fig. 6.



INVENTORS
James Leonard Smith
BY Max K. Kuther
J. E. Thalacco
ATTORNEY.

Patented Nov. 2, 1948 2,452,666

UNITED STATES PATENT OFFICE

2,452,666

FISH CANNING MACHINE

Max K. Kuther, Monterey, and James Leonard Smith, Pacific Grove, Calif.

Application June 23, 1944, Serial No. 541,822

5 Claims. (Cl. 226—103)

1

This invention relates to improvements in canning machines.

An object of our invention is to provide an improved canning machine embodying novel automatic means by which fish or other produce to be canned is deposited into suitable molds where it is shaped and compressed for subsequent ejection into cans.

Other objects and advantages will be pointed out hereinafter, indicated in the appended claims, or will be obvious to one skilled in the art upon an understanding of the present disclosure. For the purpose of this application we have elected to show herein certain forms and details of a fish canning machine representative of our invention; it is to be understood, however, that the embodiments of our invention herein shown and described are for the purpose of illustration only, and that therefore they are not to be regarded as exhaustive of the variations of the invention, nor are they to be given an interpretation such as might have the effect of limiting the claims short of the true and most comprehensive scope of the invention in the art.

In the accompanying drawings:

Fig. 1 is a plan view of a fish canning machine embodying the preferred principles of our invention;

Fig. 2 is a sectional view taken substantially on the line 2—2 of Fig. 1;

Fig. 3 is an enlarged sectional view taken longitudinally through one of the radial arms of the rotatable carrier table;

Fig. 4 is an enlarged sectional view showing the means employed for trimming fish protruding from the cans and also the means for transferring a number of compressed fish from a receiving device to a can;

Fig. 5 is a sectional view taken on the line 5—5 of Fig. 3; and

Fig. 6 is a sectional view taken on the line 6—6 of Fig. 3.

Referring to the drawings, the numeral 1 designates a suitable frame for supporting the various parts of the machine. At one end of the frame are mounted two fish conveyors 2 and 3 each of which comprises a series of concave fish holding members [illegible]

2

spaced circular knives 6 are arranged at opposite sides of the conveyors 2 and 3 for cutting the heads and tails from the fish as they are conveyed thereto. The fish are directed downwardly by curved deflector plates 7 onto the conveyors 4 and 5 after they fall by gravity from the conveyors 2 and 3. The spaced projecting members of the conveyors 4 and 5 are so arranged with respect to one another that each space therebetween is adapted to receive a single fish as it drops from the conveyors 2 and 3. Extending around one end and beneath each of the conveyors 4 and 5, respectively, are fish supporting plates 8 and 8', which terminate at predetermined delivery points. The plates 8 and 8' are arranged in positions whereby they receive and support the fish falling from the conveyors 4 and 5. The spaced projecting members of the conveyors 4 and 5 cause the fish positioned therebetween to be carried along the supporting plates 8 and 8' to the ends thereof, at which points they are discharged therefrom and fall by gravity onto other parts of the apparatus as will be later described.

Secured to a vertical shaft 9 is a rotatable star wheel 10 having a predetermined number of uniformly spaced radial members which are arranged to rotate within an open top receptacle 11. The fish from the conveyor 4 are directed by the plate 8 onto the bottom of the receptacle 11 and the radial members of the wheel 10 slide or carry them in a clockwise direction to a discharge opening 11' in the bottom of the said receptacle through which they then drop. The movement of the conveyor 4 and the rotation of the wheel 10 are so synchronized as to provide for the depositing of a certain number of fish between each of the radial members. In the particular example herein illustrated there are two fish dropped between each of the wheel's radial members.

Secured to a vertical shaft 12 is a rotatable carrier table 13 carrying a plurality of radial supporting arms 14 (here shown as sixteen in number) which are uniformly spaced one from another. Each of the radial supporting arms 14 has an open top fish receiver 15 secured thereto.

UNITED STATES PATENT OFFICE

2,432,666

FISH CANNING MACHINE

Max K. Kuther, Monterey, and James Leonard Smith, Pacific Grove, Calif.

Application June 23, 1944, Serial No. 541,822

5 Claims. (Cl. 226—103)

1

This invention relates to improvements in canning machines.

An object of our invention is to provide an improved canning machine embodying novel automatic means by which fish or other produce to be canned is deposited into suitable molds where it is shaped and compressed for subsequent ejection into cans.

Other objects and advantages will be pointed out hereinafter, indicated in the appended claims, or will be obvious to one skilled in the art upon an understanding of the present disclosure. For the purpose of this application we have elected to show herein certain forms and details of a fish canning machine representative of our invention; it is to be understood, however, that the embodiments of our invention herein shown and described are for the purpose of illustration only, and that therefore they are not to be regarded as exhaustive of the variations of the invention, nor are they to be given an interpretation such as might have the effect of limiting the claims short of the true and most comprehensive scope of the invention in the art.

In the accompanying drawings:

Fig. 1 is a plan view of a fish canning machine embodying the preferred principles of our invention;

Fig. 2 is a sectional view taken substantially on the line 2—2 of Fig. 1;

Fig. 3 is an enlarged sectional view taken longitudinally through one of the radial arms of the rotatable carrier table;

Fig. 4 is an enlarged sectional view showing the means employed for trimming fish protruding from the cans and also the means for transferring a number of compressed fish from a receiving device to a can;

Fig. 5 is a sectional view taken on the line 5—5 of Fig. 3; and

Fig. 6 is a sectional view taken on the line 6—6 of Fig. 3.

Referring to the drawings, the numeral 1 designates a suitable frame for supporting the various parts of the machine. At one end of the frame are mounted two fish conveyors 2 and 3 each of which comprises a series of concave fish holding members secured to an endless belt. Fish, previously selected for size and in a suitably cleaned condition, are placed with their tails pointed inwardly, by hand or other means, on the conveyors 2 and 3 for delivery to two endless conveyors 4 and 5, each of which is provided with spaced projecting members arranged at predetermined distances from one another. Pairs of

2

spaced circular knives 6 are arranged at opposite sides of the conveyors 2 and 3 for cutting the heads and tails from the fish as they are conveyed thereto. The fish are directed downwardly by curved deflector plates 7 onto the conveyors 4 and 5 after they fall by gravity from the conveyors 2 and 3. The spaced projecting members of the conveyors 4 and 5 are so arranged with respect to one another that each space therebetween is adapted to receive a single fish as it drops from the conveyors 2 and 3. Extending around one end and beneath each of the conveyors 4 and 5, respectively, are fish supporting plates 8 and 8', which terminate at predetermined delivery points. The plates 8 and 8' are arranged in positions whereby they receive and support the fish falling from the conveyors 4 and 5. The spaced projecting members of the conveyors 4 and 5 cause the fish positioned therebetween to be carried along the supporting plates 8 and 8' to the ends thereof, at which points they are discharged therefrom and fall by gravity onto other parts of the apparatus as will be later described.

Secured to a vertical shaft 9 is a rotatable star wheel 10 having a predetermined number of uniformly spaced radial members which are arranged to rotate within an open top receptacle 11. The fish from the conveyor 4 are directed by the plate 8 onto the bottom of the receptacle 11 and the radial members of the wheel 10 slide or carry them in a clockwise direction to a discharge opening 11' in the bottom of the said receptacle through which they then drop. The movement of the conveyor 4 and the rotation of the wheel 10 are so synchronized as to provide for the depositing of a certain number of fish between each of the radial members. In the particular example herein illustrated there are two fish dropped between each of the wheel's radial members.

Secured to a vertical shaft 12 is a rotatable carrier table 13 carrying a plurality of radial supporting arms 14 (here shown as sixteen in number) which are uniformly spaced one from another. Each of the radial supporting arms 14 has an open top fish receiver 15 secured thereto. The fish receivers 15 are each open at opposite ends and each is preferably formed with a central semi-circular part which is slightly smaller in size than the corresponding part of a can used in the canning operation, and each receiver also has side wings which are arranged in upwardly and outwardly inclined positions. The circular counter-clockwise path through which the fish re-

ceivers 15 travel is directly beneath both the discharge end of the longer fish supporting plate 8' and the discharge opening 11' of the receptacle 11. The movement of the conveyor 5 and the rotation of the table 13 are synchronized so that a predetermined number of fish are deposited into each fish receiver 15 as it passes under the discharge end of the supporting plate 8'. In the particular example herein illustrated, there are two fish deposited with their larger ends disposed outwardly into each fish receiver from the supporting plate 8'. When each fish receiver 15 having the two already deposited fish therein reaches the discharge opening 11' of the receptacle 11, there will be deposited therein from the said receptacle two additional fish, making in all four fish. The position of the fish discharged from the receptacle 11 into each receiver will be such that their larger or head ends are pointed inwardly in the opposite direction to the two fish previously entering the receiver from the plate 8'. The counter-clockwise movement of the wheel 10 is so timed with respect to the similar movement of the table 13 and the arms 14 that two fish from the receptacle 11 are discharged into each receiver 15 when it reaches a position directly below the point of discharge. The inclined side wings of each of the receivers 15 provide suitable means for directing the received fish into the central part of the receiver where they are subsequently compressed. Associated with each fish receiver 15 is means for compressing the fish into a compact package prior to their being transferred into a can. The various fish compressing means being the same, a description of one will suffice for all. Secured to and extending upwardly from the opposite side edges of each arm 14 are spaced supports 16. Secured to a pivotal shaft 17 mounted on the supports 16 is a gear 18 and a fish compressing member 19, the latter having a semicircular end part which is of substantially the same shape as the central part of each fish receiver 15. The fish compressing member 19 is adapted to move downwardly to a position where it engages with the fish receiver 15. When the receiver and the compressing member are in engaging positions, they form a cylindrical device, open at its ends, within which the four fish may be compressed prior to their being transferred into a can. (See Figs. 3 and 4.) The fish compressing member 19 is moved upwardly and downwardly with timed reciprocating motion by means of a lever 20 having a gear 21 at one end which is in mesh with the gear 18 secured to the shaft 17. The lever is pivotally secured as at 22 to one of the supports 16 and its opposite end is provided with a roller 23 which engages externally with a suitably shaped cam 24 supported beneath the table 13. This cam 24 is of general semicircular shape and through the lever 20, the gears 21, 18 and the shaft 17, it serves to move the fish compressing member 19 downwardly to a position whereby it engages with the upper surface of the fish then located in the receiver 15. Complementary to the cam 24 is another cam 25 of general semicircular shape which is engaged internally by the roller 23 of the lever 20 after the said [illegible] the cam 24. This latter downward direction takes place after the second deposit of fish is made, this being when the receiver 15 passes the discharge opening 11' in the receptacle 11. It will be noted in Fig. 1 that the fish compressing members 19 assume different positions depending upon where they happen to be with respect to the points where the fish is admitted to the receivers 15 and where it is subsequently compressed preparatory to being transferred into a can.

Arranged in a predetermined position with respect to the discharge opening 11' of the receptacle 11 is a can delivery chute 26 which has its open discharge end positioned directly above a duplex ring-shaped track 27 secured to and carried circularly by the arms 14 (see Fig. 6). The track 27 has a plurality of uniformly spaced grooves 27' each of which is adapted to receive a can C dropping onto the track from the delivery chute 26. The lower end of the can delivery chute 26 has an opening 26' at one side which allows a can C then lodged in a groove 27' to be carried by the circularly moving track 27 past the said chute (see Fig. 6). Directly after the movement of a can C beyond the can delivery chute, the transfer of the compressed fish into the can is accomplished. Each arm is equipped with the same transfer means. Slidably mounted on each arm for outward and inward reciprocating motion through a fish receiver 15 is a pusher or plunger 28 which has a connecting rod portion extending through a supporting guide 29 on the arm. The pusher 28 is rigidly connected to a depending rod 30 extending through a slot in the arm and having a roller 31 at its lower end which engages exteriorly with a suitably shaped cam 32 supported beneath the table 13 in a position inwardly from the cam 24. A complementary cam 32' is engaged internally by the roller 31 to return the pusher to its normal position. The cam 32 is of general semicircular shape and through the roller 31 and the rod 30 it serves to move the pusher 28 outwardly against the fish then held in a compressed position inside the receiver 15. Through the cam 32 the outward movement of the pusher 28 is timed so that the compressed fish then clamped in the receiver 15 by the compressing member 19 will be pushed into the can C through the latter's inwardly disposed open end. The action of the pusher 28 in an outward direction and then inwardly is quite fast and such movement is so synchronized with respect to the compressing member 19 that the latter is in its extreme downward compressing position when the pusher is moved outwardly. Thus the compressed fish is automatically transferred into the can without loss of any substantial portion thereof. As the cans C with the fish therein are carried further in a counter-clockwise direction, they successively come to a circular rotating knife 33 which is so positioned as to cut off any excess fish which might be protruding from the open end of the can.

In order to brace the cans C and to maintain them against displacement when the pushers 28 are actuated to transfer the compressed fish thereto, a semicircular member 34 is arranged to engage with the closed ends of the cans at points where there will be an outward pressure from the

An electric motor 38 connected in the usual manner by suitable pulleys, belts, gears and cams to the various parts of the apparatus causes their timely operation to bring about the results attained. It is contemplated that suitable spraying apparatus be arranged at an advantageous location to further clean the fish either before or after their transfer to the receivers 18. It is also to be understood that various other products other than fish may be satisfactorily automatically transferred into cans by means of our improved machine.

Having described our invention, what we claim is:

1. In a produce canning machine, a carrier mounted for rotation about a substantially vertical axis, a plurality of radially disposed spaced arms on the carrier, an open top produce receiver on the outer end of each arm, means for delivering produce to the receivers, a compressing element pivoted on each arm and arranged for movement toward the produce receiver on said arm, whereby the produce in the receiver may be engaged and compressed, can delivery means for delivering open cans to the carrier, means for arranging the cans in positions whereby they may receive the compressed produce from the receivers, means on each arm and synchronized with the carrier and the compressing elements for forcing the produce from the receivers into the cans while the compressing elements are in engagement with the produce in the receivers.

2. In a produce canning machine, a rotatable carrier having a plurality of sets of produce receivers, produce compressors, and produce discharging members mounted thereon, means for delivering produce to the receivers, two stationary cam rings arranged beneath the carrier, separate means associated with each compressor and arranged in engagement with one of the cam rings for progressively actuating its associated compressor to and from an engaging position with respect to the produce in its associated receiver, and separate means associated with each produce discharging member and arranged in engagement with the other of the cam rings for actuating its associated discharging member to and from a discharging position, the means for actuating the compressors and the discharging members being synchronized to effect the discharge of produce from the receivers when the compressors have compressed the produce therein.

3. In a fish canning machine, an endless conveyor for conveying fish placed thereon to a point where they are discharged, an open fish receiver provided with a substantially horizontal flat bottom and arranged to receive fish discharged from the conveyor and having a discharge opening in the said bottom, and a star wheel mounted for rotary movement in the receiver, the said star wheel having radially disposed members arranged to engage with the fish discharged onto the bottom of the receiver and carry them to the discharge opening in said bottom.

4. In a fish canning machine, an endless conveyor for conveying fish placed thereon to a point of discharge, an open fish receiver having a substantially horizontal bottom arranged to receive fish discharged from the conveyor, the said bottom of the receiver having a discharge opening, a star wheel mounted for rotary movement in the receiver and having radially disposed members arranged to engage with fish discharged into the receiver, the said radially disposed members being arranged to successively discharge one or a number of fish through the discharge opening in the bottom of the receiver, a carrier mounted for rotary movement beneath the receiver, a number of open fish receptacles on the carrier and arranged to successively receive fish discharged from the receiver, a compressor element associated with each receptacle for compressing fish received thereby, and a pusher element associated with each receiver for discharging the compressed fish therefrom.

5. In a produce canning machine, a carrier mounted for rotary movement about a substantially vertical axis, a plurality of open produce receivers arranged to be carried along a circular path by the carrier, produce delivery means for depositing produce into the open produce receivers, a compressing member synchronized with and mounted on the carrier and associated with each produce receiver, each compressing member being arranged to engage with the produce in its associated receiver at predetermined points along the path of travel of the receivers, and a plunger mounted on and synchronized with the carrier and associated with each compressing member and arranged to be actuated when its associated compressing member is in engagement with the produce in its associated receiver, whereby the produce in the receiver may be discharged therefrom while in a compressed state.

MAX K. KUTHER,
JAMES LEONARD SMITH.

REFERENCES CITED

The following references are of record in the file of this patent:

UNITED STATES PATENTS

Number	Name	Date
556,188	Holland	Mar. 10, 1896
1,891,870	Dodge	Dec. 20, 1932
2,015,089	Rooney	Sept. 24, 1935

PLAINTIFF'S EXHIBIT No. 10

DEPOSITION OF ALFRED LEUSCHNER

a witness named in the annexed notice, being of lawful age, and being first duly sworn in the above cause, testified on his oath as follows:

* * *

Q. What size cans were the three machines from Moss Landing designed to operate on?

A. They were designed for the 300 diameter tall, the one-pound tall, what we call here the one-pound tall, which is a three-inch diameter. We call it a three hundred can.

Q. How high would that can be, three inches in diameter, but how high?

A. Four eleven high. Four, eleven-sixteenths of an inch, four eleven.

Q. Now, am I right in assuming that the—this fourth machine is just like these other three, or is it different? A. What?

Q. Was this one from Richmond different from these three machines, or all four alike?

A. No, same—built for the same size.

Q. All four the same? A. Yes.

Q. Were those machines adjustable, such that they could operate on different size cans?

A. No, no.

Q. Just the one size?

A. No, Kuther contacted me and talked to me about that several times. He wanted to rebuild them or Southern California had asked him—like French

Plaintiff's Exhibit No. 10—(Continued)
(Deposition of Alfred Leuschner.)

sardine, and, oh, another big company down there, they got several of them—if he would rebuild those machines for 211 diameter, which is a half-pound can, and he told me, "Well, it's too much work, and it's no use for me to fool around."

Q. Yes. Now, in general, what were you to do with these machines, these four machines?

A. We reduced them from a three hundred by four eleven can to a two-oh-two by three-oh-eight can.

Q. And that's two hundredths inches or——

A. Two-oh-two is two-one-eight by three-oh-eight, three eight-sixteenths, or three and a half.

Q. Now, could you describe what you did on one of those machines to put it into the condition that Wilbur Ellis wanted?

A. Well, all four machines were the same. The main deal was the cleaning. And what we changed on them is we cut the plungers from three hundred diameter down to a two-oh-two diameter. Same plungers that were in the machine. We just cut the diameter down from three inch to two-oh-two.

Q. Yes.

A. And we made inserts from a three hundred diameter to a two-oh-two.

Q. Now, inserts——

A. In other words, we made a smaller pocket and set it right into the existing pocket and soldered it in.

Q. I see. And these——

Plaintiff's Exhibit No. 10—(Continued)
(Deposition of Alfred Leuschner.)

A. So we reduced the diameter for them.

Q. Referring to the drawings of this patent, those pockets in figure——

A. Yes, those are—these pockets here, yes. We reduced these pockets.

Q. ——in figure 1 are identified as fifteen. That would be these?

A. Fifteen, yes, that's right.

Q. And this patent we'll put in as Exhibit 3. Go ahead, what else?

A. And that fifteen is the pocket. The plunger is—was cut down from three inches to two-oh-two, two and one-eighth, in other words. Let's see, is number——

Q. That would be twenty-eight on Figure 3; that is the third page of drawings there. Did you change the length of the stroke of that plunger?

A. No, stroke was not changed. The guide railing was moved according to the size of the can. The same guide railing that was on, we cleaned it——

Q. Now, the guide railing, is that shown on this drawing?

A. It's—guide railing—it does not show in figure one—it ought to show here.

Q. Would that be this thirty-four going around the outside of the machine?

A. It's this railing here.

Q. Yes, thirty-four.

A. Oh, thirty-four, yes; moved that in.

Plaintiff's Exhibit No. 10—(Continued)
(Deposition of Alfred Leuschner.)

Q. You moved that in towards the——

A. Yes, because this can is shorter.

Q. Towards the center of the machine?

A. That's right. And we made these—is this the two supports here? Yes, these two supports here, naturally—those are two halves.

Q. Supports for which now?

A. For the can, can supports for these cans ride in. We made these two supports, see.

Q. Would that be this plate 27 that has the dimples that the cans ride in?

A. Yes, that's right, yes. It's this support here.

Q. All right.

A. That's all we made there. That was——

Q. You made that?

A. We made that, since the old ones were all rusted away and we needed a smaller diameter anyway, so that's——

Q. Well, even if the old plate had not been rusted, it would not have fitted?

A. No, we could have made inserts, though.

Q. I see. A. Yes.

Q. But as it was, it would not have handled those cans?

A. No, it wouldn't have handled those cans, no.

Q. I see. We have some knives, I think they are marked as 6 on this Figure 1, for cutting off the heads and tails of the fish. Did you have to change those? A. No. We put new knives on.

Plaintiff's Exhibit No. 10—(Continued)
(Deposition of Alfred Leuschner.)

Q. Well, are those knives to cut the fish to the length of the can or not?

A. Yes, they are adjustable, you can set them to the length of the can.

Q. I see. They were originally adjustable, too?

A. Yes, yes, yes.

Q. I see.

A. No, we just bought new knives because the old ones were broken out and rusted, so we just bought new knives and put new knives on.

Q. The chute here for delivering cans, it's marked as 26 in Figure 6 on the last page of drawings here, did you have to change that to accommodate the new size of cans?

A. To deliver the incoming empty cans?

Q. The incoming empty cans, that's right.

A. Yes, we had to narrow that down, yes, to the size of the smaller can.

Q. I see. Now, after you finished rebuilding these machines, would it be possible to use them for one-pound cans, or are they only good for the five-ounce cans now?

A. Well, a fellow could take the inserts out again and reconvert them over to the one-pound tall again.

Q. Well, you would have to put on new plungers?

A. Would have to cut the old plungers off and weld on new plungers, yes.

Q. Have to put on a larger can delivery chute?

Plaintiff's Exhibit No. 10—(Continued)
(Deposition of Alfred Leuschner.)

A. Yes, would have to extend the whole thing back in its original position, yes.

Q. And would have to move that guide rail back?

A. Guide rail out again, yes. See, the holes for the one-pound tall was there already. We just moved them in and drilled different holes.

* * *

[Endorsed]: Filed March 20, 1961.

DEFENDANT'S EXHIBIT D

In the United States District Court, Northern District of California, Southern Division

Civil Action No. 38418

MAX K. KUTHER, an Individual,

Plaintiff,

vs.

ALFRED LEUSCHNER, an Individual, Doing Business Under the Name and Style of Al's Machine Shop,

Defendant.

Civil Action No. 38859

MAX K. KUTHER, an Individual,

Plaintiff,

vs.

WILBUR-ELLIS COMPANY, a Corporation,

Defendant.

AFFIDAVIT OF ALFRED LEUSCHNER

I, Alfred Leuschner, being duly sworn, depose and state:

(1) That I am the Defendant in the above-entitled Civil Action No. 38,418;

(2) The modifications which I made in the four machines charged to infringe the patent in suit are described by me at pages 16-19 of my deposition of April 28, 1960;

(3) That in addition to the modification so described in my deposition, the rotary cutting knives, identified by reference numeral 33 in the patent and employed to trim the fish extending out of the cans, were removed from the machines and not replaced;

(4) And that no other modifications in said machines were made by me.

/s/ ALFRED LEUSCHNER.

State of California,
County of Santa Clara—ss.

Subscribed and sworn to before me this 20th day of March, 1961.

[Seal] /s/ ROBERT H. MINOR,
Notary Public.

[Endorsed]: Filed March 27, 1961.

[Title of District Court and Cause.]

Nos. 38418 & 38859

CERTIFICATE OF CLERK TO RECORD ON APPEAL

I, James P. Welsh, Clerk of the United States District Court for the Northern District of California, hereby certify the foregoing and accompanying documents and exhibits listed below, are the originals filed in this Court in the above-entitled case and constitute the record on appeal herein as designated by counsel for the appellants and counsel for the appellees:

Docket Entries.

Complaint. (In 38418.)

Complaint. (In 38859.)

Filed stip. & order extending time for defendant to plead. (In 38418.)

Filed answer of Alfred Leuschner. (38418.)

Filed answer of Wilbur-Ellis Company. (38859.)

Plaintiff's notice of motion to set for trial. (38418.)

Plaintiff's notice of motion to set for trial. (38859.)

Deposition of Alfred Leuschner. (38418.) (Plaintiff's Exhibit No. 10.)

Defendant's notice & motion for summary judgment of non-infringement.

Defendant's memorandum in support of motion for summary judgment.

Affidavit of Alfred Leuschner. (Defendant's Exhibit "D.")

Plaintiff's opposition to motion for summary judgment.

Defendant's reply memorandum to opposition to motion for summary judgment.

Plaintiff's correction of the affidavit of Max K. Kuther, with affidavit of Max K. Kuther attached.

Plaintiff's trial brief.

Stipulation of counsel that deposition of Alfred Leuschner may be used in Case No. 38859.

Plaintiff's memorandum after trial.

Defendant's memorandum summarizing the issues, the contentions of the parties, the evidence and discussion.

Plaintiff's reply memorandum after trial.

Defendant's reply memorandum.

Memorandum of opinion. (Sweigert.)

Defendant's notice & motions to assess damages and to adopt proposed modification of findings, conclusions and judgment.

Plaintiff's memorandum concerning and in opposition to defendant's motions to assess damages and to adopt proposed modification of findings, conclusions and judgment.

Defendant's memorandum in reply to plaintiff's memorandum in opposition to defendant's motions to assess damages and to adopt proposed modification of findings, conclusions and judgment.

Findings of fact and conclusions of law.

Judgment.

Bill of costs, taxed at $258.30.

Notice of appeal by Defendants.

Defendant's motion & notice of motion, staying enforcement of judgment during pendency of appeal and for supersedeas bond.

Stipulation of counsel continuing hearing on motion for supersedeas bond.

Order granting stay of enforcement of judgment and for supersedeas bond in the sum of $7,000.00. (Harris.)

Defendant's designation of record on appeal and statement of points to be relied upon on appeal.

Supersedeas bond in the sum of $7,000.00, filed by Max K. Kuther.

Notice by Defendants of filing of supersedeas bond.

Plaintiff's designation of additional contents of record on appeal.

Order extending time for filing record on appeal.

1 vol. reporter's transcript, proceeding of trial, April 26, 1961.

Plaintiff's exhibits Nos. 1-2-3-4-5-6-7-8-9-10-11.

Defendant's exhibits A-B-C-D-E-F-G-H.

In Witness Whereof, I have hereunto set my hand and affixed the seal of said District Court, this 5th day of February, 1962.

[Seal] JAMES P. WELSH,
Clerk;

By /s/ HARRY R. OLIVER,
Deputy Clerk.

[Endorsed]: No. 17756. United States Court of Appeals for the Ninth Circuit. Alfred Leuschner, an Individual, Doing Business Under the Name and Style of Al's Machine Shop; and Wilbur-Ellis Company, a Corporation, Appellants, vs. Max K. Kuther, an Individual, Appellee. Transcript of Record. Appeal from the United States District Court for the Northern District of California, Southern Division.

Filed: Feb. 5, 1962.

Docketed: Feb. 19, 1962.

/s/ FRANK H. SCHMID,
Clerk of the United States Court of Appeals for the Ninth Circuit.

United States Court of Appeals
for the Ninth Circuit

Case No. 17756

ALFRED LEUSCHNER, an Individual, Doing Business Under the Name and Style of Al's Machine Shop; and WILBUR-ELLIS COMPANY, a Corporation,

Appellants,

vs.

MAX K. KUTHER, an Individual,

Appellee.

APPELLANTS' STATEMENT OF POINTS AND DESIGNATION OF RECORD

The points upon which appellants intend to rely on their appeal are:

1. There is no proper basis in law for the following conclusions of law made by the trial court: III; IV; V; VI; VII; IX; XII; and XIII.

2. There is no proper basis in law for the following paragraphs of the Judgement of the trial court: IV; V; and VI.

Appellants designate the following parts of the record as being material to the consideration of their appeals:

1. The pleadings consisting of the complaint and answer in each of the two consolidated cases.

2. The "Memorandum of Opinion," filed on July 6, 1961, of the trial court.

3. The findings of fact and conclusions of law adopted and entered by the trial court.

4. The judgment entered by the trial court on October 9, 1961, and the district court clerk's notice as to the entry thereof.

5. The notice of appeal, dated November 7, 1961, and the district court clerk's notice as to the date of the filing thereof.

6. Exhibit No. 1 (a copy of the patent in suit).

7. From line 20, page 14, through line 5, page 20 of Exhibit No. 10 (the transcript of the deposition of Alfred Leuschner).

8. Exhibit D (the affidavit of Alfred Leuschner).

Our check covering the docket fee on appeal is enclosed.

Dated: February 14, 1962.

Respectfully submitted,

NAYLOR & NEAL,
JAMES M. NAYLOR,
FRANK A. NEAL,

By /s/ FRANK A. NEAL,
Attorneys for Appellants.

Receipt of copy acknowledged.

[Endorsed]: Filed February 15, 1962.

[fol. 58]

IN UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

Before: Jertberg, Merrill, Circuit Judges, and Pence, District Judge.

MINUTE ENTRY OF ARGUMENT AND SUBMISSION—
October 2, 1962

This cause coming on regularly for hearing or submission, Mr. Frank A. Neal, argued for the appellant, and Mr. Carlisle M. Moore, argued for the appellee, thereupon the Court ordered the cause submitted for consideration and decision.

[fol. 59]

IN UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

Before: Jertberg, Merrill, Circuit Judges, and Pence, District Judge.

MINUTE ENTRY OF ORDER DIRECTING FILING OF OPINION AND DISSENTING OPINION AND FILING AND RECORDING OF JUDGMENT—January 29, 1963

Ordered that the typewritten opinion and dissenting opinion this day rendered by this Court in above cause be forthwith filed by the Clerk and that a judgment be filed and recorded in the minutes of this Court in accordance with the majority opinion rendered.

[Vol. 60]

IN UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

No. 17,756

ALFRED LEUSCHNER, an Individual, Doing Business Under the Name and Style of AL'S MACHINE SHOP; and WILBUR-ELLIS COMPANY, a Corporation, Appellants,

vs.

MAX K. KUTHER, an Individual, Appellee.

Appeal from the United States District Court for the Northern District of California, Southern Division.

OPINION—January 29, 1963

Before: Jertberg and Merrill, Circuit Judges, and Pence, District Judge.

PENCE, District Judge:

Appellee, Kuther (plaintiff below), was the owner of a patented fish canning machine. All machines manufactured with the authority of the patentee were made solely to pack fish into one-pound size cans, 3 inches in diameter and 4-11/16ths inches high. The four machines involved here, when new, sold for between $8,000 to $10,000, and appellee was paid a royalty of $1,500 per machine. The machines were designed to pack small fish such as sardines, and because of their construction and mode of operation would be useless to pack large fish such as salmon. As the patented machines were manufactured, whole small fish were delivered to small, open-top, U-shaped fish receivers in such a manner that the fish headed half in one direction and half in the other, so that the fish would be interlaced when packed in the can. A compressor moved into the U-shaped fish receiver so that the interlaced fish formed a cylinder having a diameter slightly less than the can

[fol. 61] into which they were to be packed. A plunger then forced the cylinder of fish from the receiver into the can.

Wishing to can smaller sardines into smaller cans than those for which the patented machines had been built, Wilbur-Ellis Company, one of the appellants (and a defendant below), bought four secondhand machines. Three of the four machines had been inoperative since 1952 and had been left standing in an old packing plant until 1958, uncared for, and exposed to rain and salt air, so that they had become corroded and frozen solid to the extent that they were inoperable when purchased. The fourth machine as originally built was the same as the three above described. All the machines as built were not adjustable, but were designed to pack fish into the one-pound size cans, exclusively.

Wilbur-Ellis first approached Kuther to rebuild the machines for packing half-pound cans, but he had replied: "Well, it's too much work, and it is no use for me to fool around." So, thereafter, without securing Kuther's consent, Wilbur-Ellis hired Leuschner, another appellant (and a defendant below), to put the machines in shape to can fish in the can size desired by Wilbur-Ellis.

To do this, Leuschner had to clean and sandblast the corrosion from the machines to make them operable, and replace certain can supports which, although normally as long-lived as the machine, had rusted away. Certain plungers, originally designed of a diameter for one pound cans, were so corroded that they could be rendered operable only if they were replaced or were ground down, which grinding would reduce their diameter so that the plungers would no longer be operable for their original purpose, i.e., to force the cylinder of fish into one pound cans. Under the direction of Wilbur-Ellis, Leuschner ground down the plungers and fitted inserts into certain pockets and compressors to change and reduce their original size so that they could be used for packing smaller cans. He also changed certain other parts of the machine, including the guide rails for the cans after they were filled with fish, so that the rails would handle only five ounce cans, which were but 2⅛ inches in diameter and 3½ inches long.

Leuschner, on instructions of Wilbur-Ellis, altogether made six changes in the thirty-five elements which, combined together, made up the patented fish canning machine. [fol. 62] As to the rest of the different elements of the machine, no changes were made as to either size, position or replacement. Of the six changes, the can tracks, plungers, receivers and compressors were rusted or corroded to the point that their replacement was called for if the machines were to be made operable as originally built, i.e., to pack one pound cans. Instead of replacement with parts of the original size, each such element was reduced in size or so changed that the machine could thereafter be used only in packing the five-ounce size can desired by Wilbur-Ellis.

Kuther, as owner of the patent monopoly, thereafter brought suits for infringement against Wilbur-Ellis, as well as Leuschner. The District Court in a well-reasoned opinion found such infringement, and gave judgment for Kuther (and against both defendants, jointly and severally) for $6,000, i.e., $1,500 per machine—that being the royalty he normally received from the sale of machines manufactured under license by him.

The arbitrary refusal of Kuther to rebuild the machines gave Wilbur-Ellis no right to do such rebuilding themselves. It is well settled that it is the exclusive privilege of the owner of a patent monopoly to permit the use of his patent or deliberately keep his invention out of use during the life of the patent, regardless of his motive. *Paper Bag Patent Case*, 210 U.S. 405.

As was first stated in *Wilson* v. *Simpson*, 9 How. 109, 123 (1850), it is the use of the whole patented combination which a purchaser buys, and repair or replacement of a worn-out, damaged or destroyed part which renders the combination inoperable is but an exercise of the right "to give duration to that which he owns, or has a right to use as a whole", and it is permissible to restore the machine to the original use for which it was bought. This rule was reaffirmed in *Aro Mfg. Co.* v. *Convertible Top Co.*, 365 U.S. 336 (1961), the Court holding that the patentee's monopoly cannot and does not prevent those to whom the patented machine is sold from reconditioning articles worn

by use unless in fact they make a new article (p. 343). "In order to call the monopoly, conferred by the patent grant, into play for a second time, it must, indeed, be a second creation of the patented entity . . ." (p. 346).

Weighed on the above scales, the work performed by the appellants on the machines was not simply "maintenance [fol. 63] of the 'use of the whole' of the patented combination through replacement (and repair) of a spent unpatented element", but was such "a true reconstruction of the entity as to 'in fact make a new article'." *Aro* v. *Convertible Top, supra,* 346. The record is crystal clear that appellants made no attempt simply to replace worn-out parts in order to make the machines operate as originally manufactured. They deliberately modified and changed the machines in six different particulars in order to make each machine fit Wilbur-Ellis' own specific purposes, viz., the packing of five ounce rather than one pound cans of fish. Granting that appellants had the right to repair and patch each part of the fish canning machines which they bought and paid for to make the machines last as long as possible (*Cf. Aro, etc.* 357), such right did not entitle them to use that patented combination in making over the machines into fundamentally different machines from those which Wilbur-Ellis purchased, i.e., to "make a new article."

The appellants went beyond the limits of preservation of a machine's fitness as laid out in *Leeds & Catlin Co.* v. *Victor Talking Machine Co. (No. 2)*, 213 U.S. 325, 336, viz.: "The license granted to a purchaser of a patented combination is to preserve its fitness for use so far as it may be affected by wear or breakage. Beyond this there is no license."

Appellants insist, however, that theirs was not an unauthorized reconstruction of the machines, but rather that, in the course of exercising their right of repair (without making any changes in the operating procedure of the machine), they did but modify each machine to pack a smaller size can, and that change in size alone does not normally constitute reconstruction. In justification of their position, they rely upon *Hess-Bright Mfg. Co.* v. *Bearings Co. of Pennsylvania*, 271 Fed. 350 (D.Ct. Pa. 1921), and

Tabulating Machine Company v. *Durand* (Sup.Ct. D.C. 1910), 150 Official Gazette. Appellants urge that, as was done in the *Hess-Bright case, supra,* in order to render the plungers operable, it was necessary to grind them down to a smaller diameter, thereby making it impossible for the machines to pack the one pound can, and rendering the machines usable only for handling the small, five ounce cans, and that similarly, the receivers and compressors could be salvaged only by fitting inserts which would [fol. 64] minimize their original size. Appellants also insist that since the only change in the patented combination, resulting from their "repairs", pertain solely to size of the can which the machine would ultimately handle, they were authorized to do so under authority of the statement made in *Tabulating Machine, etc., supra:* "I don't understand . . . that invention ever resides in the size of a machine alone."

The *Hess-Bright* and *Tabulating Machine* cases were each single judge decisions, and in each, the line of demarcation between repairs and making over was very thin. The result in each was reached on the peculiar set of facts presented. Whatever slight virility the dicta in each case, viz., that the identity of the invention is not lost by a change in size, may have had, it has been emasculated by *George Close Co.* v. *Ideal Wrapping Mach. Co.,* 29 F.2d 533, 535 (C.A. 1 1928), *Miller Hatcheries, Inc.* v. *Buckeye Incubator Co.,* 41 F.2d 619 (C.A. 8 1930) and *Cinema Patents Co. Inc.* v. *Columbia Pictures Corporation,* 62 F.2d 310 (C.A. 9 1932). Cf. also *National Cash Register Co.* v. *Grobet,* 153 F. 905 (C.A. 2 1907). The rule (as stated in *Close* v. *Ideal, supra,* dealing solely with the problem of a change in size of a patented combination) that the sale of a machine embodying the invention, while carrying the right to use the invention, does not give to the purchaser the right to rebuild the purchased machine into other machines embodying the patent invention, is inferentially affirmed by *Aro, etc., supra.*

Here the appellants did not simply repair Kuther's patented machines, they reconstructed, rebuilt and modified each to suit Wilbur-Ellis' desires. In so doing, they embodied therein Kuther's patented combination, thus clearly infringing upon Kuther's patent monopoly.

The judgment of the District Court is affirmed.

MERRILL, Circuit Judge, dissenting

I cannot agree that the fact that these machines as restored wound up operating on five ounce cans instead of one pound cans has, apart from other considerations, resulted in a destruction of their original identity and the creation of new machines. The question to me should be [fol. 65] whether the alterations necessary in order to accomplish this result were of such a character as to amount to reconstruction under recognized tests such as those discussed in Aro Manufacturing Company v. Convertible Top Company, 1961, 365 U.S. 336.

The district court has not found on these matters. Its consideration was limited to the question, as stated in its opinion, "Whether it is infringement for the possessor of a patented combination designed to pack one pound cans only, to so change essential parts that the machine will pack five ounce cans only."

Here it would appear that the replacements did not newly create a patented combination, but that they simply bore on the useful capacity of the old combination on which royalty had already been paid—the very combination which by sale had been released from monopoly.

It is apparent from the opinion of the district court that it was concerned with the patentee's right to refrain from manufacture of machines to handle other sizes or for other purposes. If the patentee has commercial concern with the sort of use to which the machine (or combination) is to be put, he can and should protect himself by the commercial arrangement by which the patent is released. If released by sale, the combination sold should, in my view, be regarded as released in all its full usefulness until that usefulness is spent.

For these reasons, I would reverse.

(Endorsed) Opinion and Dissenting Opinion Filed January 29, 1963.

Frank H. Schmid, Clerk.

[fol. 66]

IN UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

No. 17,756

ALFRED LEUSCHNER, an individual dba Under the Name and Style of Al's Machine Shop., etc., Appellants,

vs.

MAX K. KUTHER, an Individual, Appellee.

JUDGMENT FILED AND ENTERED—January 29, 1963

Appeal from the United States District Court for the Northern District of California, Southern Division.

This Cause came on to be heard on the Transcript of the Record from the United States District Court for the Northern District of California, Southern Division and was duly submitted.

On Consideration Whereof, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is affirmed.

[fol. 67] Clerk's Certificate to foregoing transcript (omitted in printing).

[fol. 68]

SUPREME COURT OF THE UNITED STATES

No. 1024—October Term, 1962

WILBUR-ELLIS COMPANY, et al., Petitioners,

vs.

MAX K. KUTHER

ORDER ALLOWING CERTIORARI—May 20, 1963

The petition herein for a writ of certiorari to the United States Court of Appeals for the Ninth Circuit is granted.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.